

## **REMARKS**

### **Status Of Application**

Claims 14-21 are pending in the application; the status of the claims is as follows:

Claims 15-21 are objected to because of informalities.

Claims 14-20 are rejected under 35 U.S.C. §102(b) as being anticipated by Applicant Admitted Prior Art ("APA").

Claims 14-21 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,738,566 to Li et al. ("Li et al.").

Claims 14-21 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,699,102 B2 to Reiley et al. ("Reiley et al").

The indication, in the Office Action, that the Examiner has no objections to the drawings filed on March 29, 2004, is noted with appreciation.

### **Objection to the Title**

The objection to the title of the invention as not being descriptive is noted and a new title is presented in this Amendment which is clearly indicative of the invention to which the claims are directed. Accordingly, reconsideration and withdrawal of the objection is respectfully requested.

### **Objection to the Claims**

Objection is made to claims 16 and 19 that "measuring resistance" is not shown in the specification. Applicants respectfully disagree. The specification states in paragraph [0024], lines 14-16: "The controller 385 senses an electrical resistance of the electrical

lapping guides 375, which changes as portions of the electrical lapping guides 375 adjoining the upper edge of 355 are lapped away.” Applicants respectfully submit that the cited limitations of claims 16 and 19 are supported by the specification.

Objection is made to claims 15-21 as beginning with “A method” as opposed to “The method.” Applicants respectfully submit that the use of an indefinite article to begin a dependent claim is not objectionable. See the examples of acceptable claims in MPEP § 608.01(n). Claims 15-20 have been amended to address the other cited objections.

### **Claim Amendments**

Claims 14-20 have been amended to more particularly point out and distinctly claim the invention. These changes do not introduce any new matter.

### **New Claims**

New claims 22 and 23 have been added. The patentability of these new claims is discussed with the patentability of claims 14-21 below.

### **35 U.S.C. § 102(b) and § 102(e) Rejections**

The rejection of claims 14-20 under 35 U.S.C. § 102(b) as being anticipated by APA, is respectfully traversed based on the following:

In contrast to the prior art techniques described in the background of applicants’ specification, claim 14 includes the steps of:

forming a plurality of transducer elements positioned between a first edge of the substrate and a second edge of the substrate, the second edge opposing the first edge; and

forming at least one resistive element on the surface of the substrate between two of the at least two transducer elements, wherein the plurality of transducer elements includes a first transducer and a last transducer, the first transducer having no resistive elements positioned between the first

transducer and the first edge and the last transducer having no resistive elements positioned between the last transducer and the second edge;

The cited references do not show or suggest the limitations that “the first transducer having no resistive elements positioned between the first transducer and the first edge and the last transducer having no resistive elements positioned between the last transducer and the second edge.” Therefore, at least two transducers must not have a resistive element between the transducers and an edge. To anticipate, every limitation of the claim must be shown in the reference. MPEP § 2131. Therefore, claim 14 is not anticipated by the cited references. Claims 15-21 and new claims 22 and 23 are dependent upon claim 14 and thus include every limitation of claim 14. Therefore, claims 15-21 and new claims 22 and 23 are also not anticipated by the cited references.

Accordingly, it is respectfully requested that the rejection of claims 14-20 under 35 U.S.C. § 102(b) as being anticipated by APA, be reconsidered and withdrawn.

The rejection of claims 14-21 under 35 U.S.C. § 102(b) as being anticipated by Li et al., is respectfully traversed based on the following:

Li shows forming a plurality of transducer pairs 23a and 23b in a substrate. An electronic lapping guide (ELG) 20 is formed adjacent to, but not between, each transducer pair. Of importance, a row of ELGs 20 is formed on the left edge of the substrate in Figures 1 and 3.

In contrast to the cited references, claim 14 includes the steps of:

forming a plurality of transducer elements positioned between a first edge of the substrate and a second edge of the substrate, the second edge opposing the first edge; and

forming at least one resistive element on the surface of the substrate between two of the at least two transducer elements, wherein the plurality of transducer elements includes a first transducer and a last transducer, the first transducer having no resistive elements positioned between the first

transducer and the first edge and the last transducer having no resistive elements positioned between the last transducer and the second edge;

As noted above, the cited references do not show or suggest the limitations that “the first transducer having no resistive elements positioned between the first transducer and the first edge and the last transducer having no resistive elements positioned between the last transducer and the second edge.” Therefore, at least two transducers must not have a resistive element between the transducers and an edge. To anticipate, every limitation of the claim must be shown in the reference. Therefore, claim 14 is not anticipated by the cited references. Claims 15-21 and new claims 22 and 23 are dependent upon claim 14 and thus include every limitation of claim 14. Therefore, claims 15-21 and new claims 22 and 23 are also not anticipated by the cited references.

Accordingly, it is respectfully requested that the rejection of claims 14-21 under 35 U.S.C. § 102(b) as being anticipated by Li et al., be reconsidered and withdrawn.

The rejection of claims 14-21 under 35 U.S.C. § 102(e) as being anticipated by Reiley et al., is respectfully traversed based on the following.

Reiley shows a block 18 (Fig. 2) with a plurality of magneto-resistive heads 26. Each magneto-resistive head has an associated lapping indicator 32. As shown in Figure 2, a lapping indicator is positioned to the right of each of the magneto-resistive heads, including the right-most magneto resistive head.

In contrast to the cited references, claim 14 includes the steps of:

forming a plurality of transducer elements positioned between a first edge of the substrate and a second edge of the substrate, the second edge opposing the first edge; and

forming at least one resistive element on the surface of the substrate between two of the at least two transducer elements, wherein the plurality of transducer elements includes a first transducer and a last transducer, the first transducer having no resistive elements positioned between the first

transducer and the first edge and the last transducer having no resistive elements positioned between the last transducer and the second edge;

As noted above, the cited references do not show or suggest the limitations that “the first transducer having no resistive elements positioned between the first transducer and the first edge and the last transducer having no resistive elements positioned between the last transducer and the second edge.” Therefore, at least two transducers must not have a resistive element between the transducers and an edge. To anticipate, every limitation of the claim must be shown in the reference. Therefore, claim 14 is not anticipated by the cited references. Claims 15-21 and new claims 22 and 23 are dependent upon claim 14 and thus include every limitation of claim 14. Therefore, claims 15-21 and new claims 22 and 23 are also not anticipated by the cited references.

Accordingly, it is respectfully requested that the rejection of claims 14-21 under 35 U.S.C. § 102(e) as being anticipated by Reiley et al., be reconsidered and withdrawn.

### **CONCLUSION**

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin LLP Deposit Account No. 18-1260.


If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be

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construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin LLP Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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